

REMARKS

Entry of this amendment is respectfully requested.

The indication of allowable subject matter is gratefully acknowledged.

It is not believed that any of the objections or the 35 U.S.C. §112, second paragraph, rejection apply to the presently pending claims.

Claims 31, 33-35, 37-49, 51-69, 74, 78 and 80 were rejected under 35 U.S.C. §103(a) over WO 00/24545 (Wichelhaus I) or Wichelhaus US 6,479,103 (Wichelhaus II). Applicants respectfully traverse each of these rejection.

The Examiner acknowledges that these references fail to teach a composition containing the pigments in the claimed ratio as set forth claim 31, nonetheless, he concludes that minor changes such as “adding a minuscule amount of MoS2 would result in ratios for components that either lie inside, or lie close to instant claimed ranges” so the claims are obvious and unpatentable. The Examiner, however, clearly uses hindsight in this analysis- in other words, he starts from the ranges of the pending claims, and alleges that one would arrive at the claimed ranges by adding certain components. What is missing from this analysis is why one would do so without impermissibly using Applicants claims and specification as a guide. The fact that one could make such changes, is much different than learning that one should do so based on the disclosure of the cited references.

Furthermore, the Examiner has failed to show where the feature “the particle size of substance A, based on the particle size transfer value d_{99} measured with a Mastersizer of type S from Malvern Instruments, is less than 10 μm ” is disclosed; he has only referred to a mesh size which only means that the particles larger than a certain size are not present. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Therefore, this rejection must be withdrawn.

Claims 31, 33-35, 37-49, 52-69, 74 and 80 were rejected under 35 U.S.C. §103(a) over Soltwedel. Applicants respectfully traverse.

Similar to the rejection discussed above, the Examiner alleges that this reference discloses ranges that overlap with those of claim 32. However, claim 31 has been amended to incorporate the subject matter of claim 32, and it is respectfully submitted that none of the cited references specifically disclose that feature with the particular ranges.

Furthermore, the Examiner has failed to show where the feature “the particle size of substance A, based on the particle size transfer value d_{99} measured with a Mastersizer of type S from Malvern Instruments, is less than 10 μm ” is disclosed; he has only referred to a mesh size which only means that the particles larger than a certain size are not present. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Thus, this rejection should be withdrawn.

The provisional double patenting rejection will be addressed upon resolution of the obviousness rejections.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0624, under Order No. NY-DNAG-291-US. A duplicate copy of this paper is enclosed.

Respectfully submitted

FULBRIGHT & JAWORSKI L.L.P.

By /James R. Crawford/
James R. Crawford
Reg. No. 39,155

666 Fifth Avenue
New York, New York 10103
(212) 318-3000